

Contrary to the Action's contention, the invention disclosed in the Barrett reference does not teach a material "with an index of refraction substantially the same as that of corneal tissue" as is required in Applicant's independent claims 1 and 11.

Anticipation requires that each and every element of the claimed invention be described, either expressly or inherently, in a single prior art reference. *Telemac Cellular Corp. v. Topp Telecom, Inc.*, 247 F.3d 1316, 1327, 58 U.S.P.Q.2d 1545, 1552 (Fed. Cir. 2001); *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Moreover, anticipation under section 102 is only valid when a reference shows exactly what is claimed; where there are differences between the references disclosures and the claim, a rejection must be based on obviousness under Section 103. *Richardson v. Suzuki Motor Co., Ltd.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989).

In describing the problem with the prior art, the Barrett reference states in column 3, lines 64-67 that "none of the prior art inlay lenses provide for multiple focality, which is highly desirable in many patients." In addressing the problem, the Barrett reference in column 4, lines 59-60 states that "the lenses of the invention provide multiple refractive indices and multiple focalities." The Barrett reference goes on to state in column 5, lines 12-15 states that "[s]uch lenses create regions of different refractive indices within the optic zone, one *created by the lens itself* and the other by the *neighboring stroma tissue*, thereby providing a *useful multifocal* capability" (emphasis added). Also, see claim 1 of the Barrett, column 8, lines 45, stating that "when implanted in the eye multiple refractive indices and multiple focalities are created only by the presence or absence of said lense."

In teaching the useful multifocality capability, the Barrett reference sets forth various materials for the corneal inlays, each of which have a refractive index greater or equal to 1.42.

See column 6, lines 59-60 – a R.I. of 1.42 to 1.43

See column 6, lines 66-67 – a R.I. of 1.633

See column 7, line 5 – a R.I. of 1.49

See column 7, Example 1 – PMMA (which has an index of refraction 1.49 or higher)

See column 7, Example 2 – R.I. of 1.425

See column 8, Example 3 – R.I. of 1.425

Incidentally, the index of refraction of the corneal tissue is in the range of 1.36 to 1.39. Applicant's claimed lens utilizes a material with a refractive index substantially the same as that of the neighboring stroma tissue. By utilizing a material for a lens with an index of refraction substantially the same as that of corneal tissue, then Barrett's useful multifocal capability is not obtained.

Clearly, the Barrett reference does not teach each claim limitation of Applicant's claimed inventive corneal implant and in fact teaches away from Applicant's corneal implant. Applicant's claimed invention is patentably distinguishable over the Barrett reference. Accordingly, Applicant respectfully requests that the rejection of claims 1-17 under 35 U.S.C. § 102(b) as anticipated be withdrawn.

#### C. Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2375, under Order No. HO-P01709US6 from which the undersigned is authorized to draw.

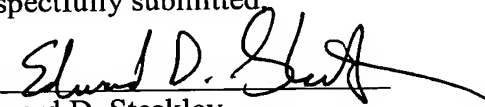
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Respectfully submitted,

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